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REMARKS

Applicants have reviewed and considered the Office Action mailed on September 21, 2006, and the references cited therewith. Claims 1, 2, 5, 7-10, 13, and 14 are pending and rejected. Applicants respectfully request reconsideration and allowance of all claims in view of the following remarks.

It is to be understood that Applicants do not acquiesce to the Examiner's characterizations of the art of record or to Applicants' subject matter recited in the pending claims. Further, Applicants are not acquiescing to the Examiner's statements as to the applicability of the prior art of record to the pending claims by filing the instant response.

Claims 1, 2, 5 and 8 patentable over Ellis under §102

Claims 1, 2, 5 and 8 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,986,650 to Ellis et al. ("Ellis"). The rejection is traversed.

According to MPEP §2131, to anticipate a claim under §102, the reference must teach every element of the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "When a claim covers several structures or compositions, either generically or as alternatives, the claim is deemed anticipated if any of the structures or compositions within the scope of the claim is known in the prior art." *Brown v. 3M*, 265 F.3d 1349, 1351, 60 USPQ2d 1375, 1376 (Fed. Cir. 2001). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Claim 1 recites, *inter alia*,

A method, comprising:
generating, at a headend, at least one bitmap for a channel information window;

encoding, at the headend, a broadcast video presentation and the bitmap for the channel information window, the broadcast video presentation being programming from one of a plurality of channels;

transmitting, from the headend to a set top terminal, the broadcast video presentation and the bitmap for the channel information window;

receiving, at the set top terminal, a signal to activate the channel information window;

decoding, at the set top terminal, the broadcast video presentation and the bitmap for the channel information window; and

compositing, at the set top terminal, the bitmap for the channel information window and the broadcast video presentation to produce a video stream for a display so that the channel information window overlays and obscures at least a portion of the broadcast video presentation on the display. (emphasis added).

The present invention generates such a window at a server in a cable headend or other distribution center. Because the window is generated at a server in accordance with the present invention, rather than at a terminal, there terminal may be simplified and made less expensive. Thus, the window is remotely generated and then transmitted to the set top terminal. This feature is not taught or suggested by the references.

Ellis fails to teach each and every element of the claimed invention. For example, Ellis fails to teach encoding, at the headend, the channel information windows, transmitting, from the headend to the set top terminal, the channel information windows, and decoding, at the set top terminal, the broadcast video displays and the channel information windows.

The Applicants respectfully submit that the Examiner has interpreted Ellis too broadly. The Examiner asserts because Ellis teaches that the stored bit maps are downloadable data that the stored bit maps are, therefore, generated and encoded at the headend. (See Final Office Action, p. 2.) Ellis fails to support the Examiner's assertion. Ellis specifically teaches that the data stream from the data provider only contains program schedule information. (See Ellis, col. 4, ll. 55-67.) Nowhere, does Ellis teach that the bitmap is generated and encoded at the headend. Simply because data is downloadable, does not necessarily mean the data comes from the head-end.

For example, a technician may "download" the bitmap into the DRAM 18 when programming the hardware taught by Ellis.

Furthermore, even if the Examiner's unduly broad interpretation of "downloadable data types such as stored bit maps" is correct, Ellis still fails to support the Examiner's assertion that the bitmap is encoded at the head end. Clearly, Ellis teaches that Fig. 1 represents system components located in a user's set top cable converter box. (See Ellis, col. 4, ll. 46-54, emphasis added.) Ellis proceeds to teach that the bit map data and program schedule information are supplied to video display generator and converted to an RGB format in accordance with the bit map for display to the user. (See Ellis, col. 6, ll. 28-44.) The video display generator performing the encoding is located in the user's set top cable converter box. (See Ellis, Fig. 1.) Therefore, Ellis clearly teaches that the user's set top cable converter box is encoding the bitmap and program schedule information. As such, the Applicants respectfully submit that the Examiner's interpretation and assertion cannot be reasonably supported by Ellis.

Accordingly, independent claim 1 and independent claim 5, which recites relevant limitations similar to those recited in independent claim 1, are not anticipated and are patentable over Ellis under 35 U.S.C. §102. For at least the same reasons discussed above, claims 2 and 8 which depend respectively from claims 1 and 5 also are not anticipated and are patentable over Ellis under 35 U.S.C. §102. Therefore, this rejection should be withdrawn.

Claims 7 patentable over Ellis/Hoarty under §103

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of U.S. Patent No. 5,485,197 to Hoarty ("Hoarty"). The rejection is traversed.

Claim 7 depends directly from claim 5 and, thus, inherits the patentable subject matter of claim 1, while adding additional elements and further defining elements.

This ground of rejection applies only to a dependent claim and is predicated on the validity of the rejection under 35 U.S.C. 102 given Ellis. Since the rejection under 35 U.S.C. 102 given Ellis has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Hoarty supplies that which is missing,

this ground of rejection cannot be maintained. Accordingly, claim 7 is non-obvious and patentable over Ellis/Hoarty under 35 U.S.C. §103. Therefore, this rejection should be withdrawn.

Claims 9, 10 and 13 patentable over Ellis/Bolanos under §103

Claims 9, 10 and 13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of U.S. Patent No. 5,793,364 to Bolanos (Bolanos). The rejection is traversed.

Claims 9 and 10

A *prima facie* case of obviousness is established when the combination of references teach or suggest all the claim elements. The combination of Ellis/Bolanos fails to teach or suggest all the elements of claims 9 and 10.

Claims 9 and 10 include the features that a bitmap for the window is remotely generated and then transmitted to the set top terminal for decoding. This feature is not taught or suggested by Ellis, as discussed above.

Moreover, Bolanos fails to bridge the substantial gap left by Ellis because Bolanos only teaches a method and system for associating playback of multiple audiovisual programs with one graphic interface element in a graphical user interface. Primary and secondary audiovisual programs are associated with the graphic interface element. A primary audiovisual program is played back when the user selects the graphic interface element. The secondary audiovisual program is played back at pseudorandom intervals without user input. The secondary audiovisual program draws the user's attention to the graphic interface element. Thus, Bolanos also does not encode windows at the headend. Moreover, Bolanos also does not transmit encoded windows from the headend to the set top terminal. In addition, Bolanos also does not decode the received encoded windows at the set top terminal.

Consequently, neither Ellis nor Bolanos teaches or suggests a bitmap for the window is remotely generated and then transmitted to the set top terminal for decoding. Thus, claims 9 and 10 are non-obvious and patentable over the proposed combination

of Ellis in view of Bolanos under 35 U.S.C. 103. Therefore, the rejections should be withdrawn.

Claim 13

Claim 13 depends directly from claim 1 and, thus, inherits the patentable subject matter of claim 1, while adding additional elements and further defining elements.

This ground of rejection applies only to a dependent claim and is predicated on the validity of the rejection under 35 U.S.C. 102 given Ellis. Since the rejection under 35 U.S.C. 102 given Ellis has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Bolanos supplies that which is missing, this ground of rejection cannot be maintained. Accordingly, claim 13 is non-obvious and patentable over Ellis/Bolanos under 35 U.S.C. §103. Therefore, this rejection should be withdrawn.

Claim 14 patentable over Ellis/Hoarty/MacInnis under §103

Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Ellis in view of MacInnis U.S. Patent No. 5,951,639 ("MacInnis").

Claim 14 depends directly from claim 1 and, thus, inherits the patentable subject matter of claim 1, while adding additional elements and further defining elements.

This ground of rejection applies only to a dependent claim and is predicated on the validity of the rejection under 35 U.S.C. 102 given Ellis. Since the rejection under 35 U.S.C. 102 given Ellis has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that MacInnis supplies that which is missing, this ground of rejection cannot be maintained. Accordingly, claim 13 is non-obvious and patentable over Ellis/MacInnis under 35 U.S.C. §103. Therefore, this rejection should be withdrawn.

THE SECONDARY REFERENCES

The secondary references made of record are noted. However, it is believed that the secondary references are no more pertinent to Applicants' disclosure than the

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primary references cited in the Office Action. Therefore, Applicants believe that a detailed discussion of the secondary references is not necessary for a full and complete response to this Office Action.

CONCLUSION

For the foregoing reasons, Applicants respectfully request reconsideration and passage of the claims to allowance. If, however, the Examiner believes that there are any unresolved issues, it is requested that the Examiner telephone Eamon J. Wall or Jimmy Kim at (732) 530-9404 so that appropriate arrangements can be made for resolving such issues as expeditiously as possible.

Respectfully submitted,

Dated: 11/15/06

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